

### **REMARKS**

Claims 1-45 are pending in this application. By this Amendment, Claims 16 and 33 have been amended to correct a perceived typographical error. Applicants therefore respectfully submit that no new matter has been added to this application nor have any new issues been raised by this amendment. Moreover, it is believed that the claims as presented herein places the application in condition for allowance. Accordingly, entry and consideration of the present Amendment is deemed appropriate as it places the application in condition for allowance.

The Examiner has objected to the specification for certain informalities, namely, to correct the filing date of the referenced patent application on page 17. Applicants have amended the specification in a manner believed to obviate the Examiner's objection. Accordingly, withdrawal of the objection is respectfully requested.

The Examiner has provisionally rejected Claims 1-3, 6, 7, 9, 11, 12, 14, 15, 19, 20, 22, 23, 26, 27, 29, 31, 32, 34, 35, and 38-45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 3-9, 15-19 and 24-30 of co-pending Application No. 10/779,422. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 1, 2, 13-18, 20-22 and 33-38 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 20 and 22-30 of co-pending Application No. 10/699,529. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 1, 2, 13-17, 20, 22, 34-37, 39-42, 44 and 45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 3, 10-18, 22 and 23 of co-pending Application No. 10/699,508. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 1, 2, 20, 22, 39, 41 and 44 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 13, 19-22 and 33-35 of co-pending Application No. 10/699,509. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has finally rejected Claims 39-42 under 35 U.S.C. §102(e) as being anticipated by Kolosov et al., U.S. Publication No. 2004/0123650 ("Kolosov et al.").

Nowhere does Kolosov et al. disclose or suggest "a system for screening lubricant performance, under program control, comprising: (a) a plurality of test receptacles, each containing a different lubricating oil composition sample comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive; (b) receptacle moving means for individually positioning said test receptacles in a testing station for measurement of storage stability in the respective sample; (c) means for measuring the storage stability in the sample moved to the testing station to obtain storage stability data associated with said sample and for transferring said storage stability data to a computer controller, wherein said computer controller is operatively connected to the means for individually moving the test receptacles" as presently recited in Claim 39.

According to the Examiner, the Kolosov et al. reference does teach of each and every one of the components recited in instant claims 39-42 and further teaches the general analysis of a large number of diverse compounds and that the compounds analyzed can be lubricants having an additive therein. It is the Examiner's apparent belief that it is inherent that in a lubricant composition having an additive therein that the base lubricant oil is present in a major amount while the additive is present in a lesser minor amount.

However, inherency may not be established by probabilities or possibilities. *Hansgirk v. Kemmer*, 40 USPQ 665, 667 (CCPA 1939). Kolosov et al. simply disclose a system and method for screening a library of a multitude of genera of material samples for rheological properties one of which may be a lubricant. However, a lubricant can be a grease, jelly, e.g., K-Y jelly, as well as powders, e.g., dry graphite, PTFE, etc., formulated with water and can be used as is such that all lubricants may not even require an additive or, for that matter, be used in a lubricating oil composition. Kolosov et al. provide no disclosure that a lubricant can even be a base oil of lubricating viscosity for use in a lubricating oil composition much less a plurality of different lubricating oil composition samples comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive. Applicants therefore respectfully disagree with the Examiner's statement on page 12 of the Office Action. As set forth above, the presently claimed system for screening lubricant performance is different than the system in Kolosov et al. Thus, Kolosov et al do not disclose all of the elements and limitations of the claimed invention. Accordingly, Claims 39-42 clearly possess novel subject matter relative to Kolosov et al. and withdrawal of the rejection under 35 U.S.C. §102(e) is respectfully requested.

The Examiner has finally rejected Claims 1-9, 18-29, 38 and 43 under 35 U.S.C. §103(a) as being unpatentable over Kolosov et al. in view of both O'Rear, U.S. Publication No. 2003/0100453 ("O'Rear") and Tolvanen et al. U.S. Patent No. 5,715,046 ("Tolvanen et al. ").

As pointed out by the Examiner, nowhere does Kolosov et al. disclose or suggest a high throughput method for screening lubricating oil additive composition samples, under program control, comprising (a) providing a plurality of different lubricating oil additive composition samples comprising at least one lubricating oil additive, each sample being in a respective one of a plurality of test receptacles; (b) maintaining each sample at a predetermined temperature for a predetermined time; (c) measuring the storage stability of each sample to provide storage stability data for each sample; and, (d) outputting the results of step (c) as presently recited in Claim 1. Nor is there any disclosure or suggestion in Kolosov of a high throughput method for screening lubricating oil composition samples, under program control, comprising (a) providing a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, each sample being in a respective one of a plurality of test receptacles; (b) maintaining each sample at a predetermined temperature for a predetermined time; (c) measuring the storage stability of each sample to provide storage stability data for each sample; and, (d) outputting the results of step (c), as presently recited in Claim 20.

According to the Examiner, since Kolosov et al. disclose the analysis of lubricant compositions having additives therein as one of the flowable materials by measuring stability parameters such as thermal degradation, aging characteristics and sedimentation of particles in the compositions in a high throughput combinatorial library format, one skilled in the art would

be motivated to perform the method and apparatus as recited in the instant claims. The Examiner goes on to state that O'Rear was used as a secondary teaching of the obviousness of measuring the stability of lubricant compositions containing additives therein by determining the formation of floc or sediment in the samples during storage at a high temperature for a predetermined time and the reference to Tolvanen et al. was used as a secondary teaching of the obviousness of determining the stability of lubricating oil compositions by measuring the intensity of light scattering from the oil sample surface. Thus, it is the Examiner's apparent belief that it would have been obvious to one skilled in the art at the time of the instant invention to screen the lubricant/additive compositions in the combinatorial array taught by Kolosov et al. for storage stability by optically measuring the formation of sediments in each of the samples, since Kolosov et al. teach that the plurality of samples in the array are screened for various material characteristics, and both O'Rear and Tolvanen et al. teach that it is common to screen lubricating oil compositions for their storage stability based upon the amount of sediment that forms in the samples over a predetermined time period at a certain temperature.

However, it well established that there must be some teaching, motivation or suggestion to select and combine references relied upon as evidence of obviousness. Moreover, obviousness cannot be established using hindsight. The fact that Kolosov et al. disclose characterizing properties such as thermal degradation, aging characteristic and sedimentation of particles of a genera of materials' disclosed therein certainly does not provide any suggestion that a lubricating oil composition can be screened by maintaining each sample at a predetermined temperature for a predetermined time and measuring the storage stability of each sample to provide storage stability data for each sample in a high throughput method. In fact, it is not seen

where Kolosov et al. even disclose sedimentation of particles therein. Instead, Kolosov et al. disclose a large number of broad tests for characterizing properties of a genera of materials such as density, melt index, thermal degradation, aging characteristics, weight-average molecular weight, number-average molecular weight, viscosity-average molecular weight, peak molecular weight, approximate molecular weight, polydispersity index, molecular-weight-distribution shape, relative or absolute component concentration, conversion, concentration, mass, hydrodynamic radius, radius of gyration, chemical composition, amounts of residual monomer, presence and amounts of other low-molecular weight impurities in samples, particle or molecular size, intrinsic viscosity, molecular shape, molecular conformation, and/or agglomeration or assemblage of molecules.

Moreover, thermal degradation tests can be used for many different applications, e.g., polymers to determine flame retardancy, foods, etc., and at no point provides any suggestion of a method for screening lubricating oil composition samples for storage stability under program control by maintaining each sample at a predetermined temperature for a predetermined time and measuring the storage stability of each sample to provide storage stability data for each sample in a high throughput method, such that one skilled in the art upon reading the disclosure of Kolosov et al. would be motivated to modify the system and method for testing the genera of flowable material with any of the broad tests disclosed therein and arrive at the specifically claimed method. Certainly, O'Rear and Tolvanen et al. do not cure the deficiencies of Kolosov et al. as O'Rear and Tolvanen et al. provide no suggestion or motivation to test lubricating oil compositions for storage stability in a high throughput method or system such that one skilled in the art would be motivated to modify the high throughput method and apparatus of Kolosov et al.

by looking to the disclosures of O'Rear and Tolvanen et al. and arrive at the claimed method with any expectation of success. Only by using applicants' disclosure as a guide has the Examiner been able to piece together the claimed invention. Accordingly, Claims 1-9, 18-29, 38 and 43 are believed to be nonobvious, and therefore patentable, over Kolosov et al. and O'Rear or Tolvanen et al. Thus, withdrawal of the rejection is respectfully requested.

The Examiner has finally rejected Claims 10-13, 30-33 and 44-45 under 35 U.S.C. §103(a) as being unpatentable over Kolosov et al. in view of both O'Rear, and Tolvanen et al. and further in view of Garr et al., U.S. Patent No. 5,993,662 ("Garr et al.").

The foregoing deficiencies of Kolosov et al., O'Rear and Tolvanen et al. discussed above with respect to the rejections of Claims 1, 20 and 39 apply with equal force to this rejection. Garr et al. does not cure and is not cited as curing the above-noted deficiencies of Kolosov et al., O'Rear and Tolvanen et al. Rather, Garr et al. is simply cited for the disclosure of employing a bar code to identify individual containers. Accordingly, Claims 10-13, 30-33, 44 and 45 are believed to be nonobvious, and therefore patentable, over Kolosov et al., O'Rear, Tolvanen et al. and Garr et al.

The Examiner has finally rejected Claims 14-17 and 34-37 under 35 U.S.C. §103(a) as being unpatentable over Kolosov et al. in view of both O'Rear and Tolvanen et al. and further in view of Smrcka et al., European Patent No. 1,233,361 ("Smrcka et al.").

The foregoing deficiencies of Kolosov et al., O'Rear and Tolvanen et al. discussed above with respect to the rejections of Claims 1 and 20 apply with equal force to this rejection. Smrcka et al. does not cure and is not cited as curing the above-noted deficiencies of Kolosov et al.,

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O'Rear and Tolvanen et al. Rather, Smrcka et al. is merely cited for its disclosure of storing test results in a data carrier.

Since Kolosov et al., O'Rear, Tolvanen et al. and Smrcka et al., alone or in combination, do not disclose or suggest the high throughput methods of Claims 1 and 20 from which Claims 14-17 and 34-37 ultimately depend, Claims 14-17 and 34-37 are believed to be nonobvious, and therefore patentable, over Kolosov et al., O'Rear, Tolvanen et al. and Smrcka et al.

For the foregoing reasons, amended Claims 1-45 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



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